

Our Reference: 600204528-9

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellant:	Yaacov Almog
Serial Number:	10/763,625
Filing Date:	January 22, 2004
Confirmation No.:	7724
Examiner/Group Art Unit:	Lawrence D. Ferguson/1783
Title:	COATING SYSTEM FOR SUBSTRATES

REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Please enter the following Reply Brief in response to the Examiner's answer dated July 8, 2010.

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I. STATUS OF CLAIMS

Claims 38, 40-43, and 45-47 are the claims on appeal.

Claims 1-37, 39, 44, 49, and 50 were cancelled.

Claims 48 and 51-58 were withdrawn.

Claims 38, 40-43, and 45-47 are rejected.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1) Whether claims 38, 40, 42, 43, 45, and 47 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Bodager, et al. (U.S. Patent No. 5,565,301, referred to herein as "Bodager").

2) Whether claims 38, 40, 41, 43, 45, and 46 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Fujimura, et al. (U.S. Patent No. 5,250,990, referred to herein as "Fujimura") in view of Graham, et al. (U.S. Patent No. 4,602,058, referred to herein as "Graham").

III. ARGUMENTS

The arguments presented hereinbelow address the Office's arguments presented in the Examiner's Answer dated July 8, 2010 (referred to herein as the "Answer"). It is submitted, however, that the absence of a reply to a specific rejection, issue, comment, or argument in the Answer does not signify agreement with or concession of that rejection, issue, comment, or argument. Finally, nothing in the following arguments of this reply brief should be construed as an intent to concede any issue with regard to any claim, except if specifically stated below.

A. Rejection of claims 38, 40, 42, 43, 45, and 47 under 35 U.S.C. § 102(b) as being anticipated by Bodager

Appellant herein reiterates all of the arguments set forth in the Appeal Brief dated April 15, 2010.

Further, in the Answer, the Office argues that Bodager discloses a coated paper substrate comprising a carrier support, which is a paper substrate (citing column 4, lines 55-67). The Office states, "[t]he reference does not disclose that the paper sheet has been treated to be water resistant, but that the synthetic paper has been treated to be water resistant." The Office concludes that Bodager meets the claim limitation of a paper substrate.

To reiterate, Bodager discloses at column 4, lines 65-67 that "[t]he carrier support can also be a thin metal sheet or a paper substrate or synthetic paper that has been treated to be water resistant." Appellant submits that the content of the foregoing disclosure in Bodager may be misconstrued due, at least in part, to its sentence structure. Appellant also realizes that any person capable of reading English prose may have some difficulty in determining whether or not the phrase "has been treated to be water resistant" modifies i) the thin metal sheet, the paper substrate, and the synthetic paper, or ii) the synthetic paper alone. However, Bodager discloses at column 4, lines 57-60 that "[t]he material used for the carrier support also should be sufficiently water resistant to allow for aqueous development of the photosensitive layer without warping or shrinking" (emphasis added). Since Bodager discloses that the material for the

carrier support may be a thin metal sheet, a paper substrate, or a synthetic paper, it is submitted that one with ordinary skill in the art would conclude that all three of these supports would be treated to be water resistant. Thus, Appellant respectfully disagrees with the Office's interpretation of the Bodager disclosure.

For the foregoing reason, as well as those set forth in the Appeal Brief dated April 15, 2010, Appellant still submits that Bodager does not disclose all of the elements of the pending claims. As such, Appellant still submits that Bodager *fails* to anticipate independent claims 38 and 43.

B. Rejection of claims 38, 40, 41, 43, 45, and 46 under 35 U.S.C. § 103(a) as being obvious over Fujimura and Graham

Appellant herein reiterates all of the arguments set forth in the Appeal Brief dated April 15, 2010.

Further, in the Answer, the Office argues that because Fujimura discloses a paper substrate, the disclosure meets the claim limitation of a paper substrate. The paper substrate in Fujimura, however, is impregnated with electroconductive particles or plastics comprising electroconductive polymers (column 8, lines 3-6; column 8, lines 24-26; and the abstract of Fujimura). Appellant still concludes that the substrate of Fujimura is *not* the same as an ordinary paper substrate.

In the Answer, the Office argues that the broadest interpretation of paper substrate includes one that includes additional materials such as, e.g., electroconductive particles. The Office bases this argument on the fact that Appellant's specification did not exclude additional materials from the paper substrate. In response thereto, Appellant reminds the Office that the *claims* are to be given their broadest interpretation that is consistent with the specification. Appellant is not aware of any rule that states that, during prosecution, the specification is to be given its broadest interpretation as well. As such, the recitation of a paper substrate means a paper substrate.

Appellant also reminds the Office that patent applications are typically described in terms of what, e.g., the coated substrate has as opposed to what it does not have.

Thus, if the specification does not disclose incorporating additional materials into the paper substrate (either in the description or in any of the examples), Appellant submits that one with ordinary skill in the art would reasonably interpret the specification to implicitly exclude the additional materials.

In view of the arguments set forth above, as well as all of the arguments recited in the Appeal Brief of April 15, 2010, it is still submitted that the combination of Fujimura and Graham still *fails* to render obvious claims 38, 40, 41, 43, 45, and 46.

IV. CONCLUSION

The Appellant respectfully submits that claims 38, 40-43, and 45-47 as currently pending fully satisfy the requirements of 35 U.S.C. §§ 102, 103 and 112. Accordingly, Appellant respectfully requests that the Board of Patent Appeals and Interferences find for the Appellant and reverse the rejection of each of Appellant's claims 38, 40, 42, 43, 45, and 47 under U.S.C. § 102(b) as being anticipated by Bodager, and claims 38, 40, 41, 43, 45, and 46 under 35 U.S.C. § 103(a) as being unpatentable over Fujimura in view of Graham. In view of the foregoing, favorable consideration and passage to issue of the present application is respectfully requested.

Respectfully submitted,

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